

REMARKS

The Official Action of April 29, 2008, made final, and the Advisory Action of August 13, 2008, and the references cited therein have been carefully considered. The Applicant respectfully requests reconsideration of the application in view of the following remarks. Consistent with Applicants' response transmitted July 29, 2008, which was not entered purusant to the Advisory Action mailed August 13, 2008, Applicants' amendments are being submitted to ensure their entry.

1. Status of the Claims

Claims 28-51 have been canceled without prejudice and rewritten for convenience in presentation as new Claims 52-77.

Claim 52 has been amended to include a definition of R2. Support for this amendment can be found throughout the specification, e.g. on pg. 7-8. Claim 28 has also been amended to exclude three named compounds by proviso.

Claims 60 has been amended to correct a typographical error. Support for the corrected text can be found on p. 10.

Claim 72 has been allowed

Claim 73 has been added to reference a specific compound within allowed Claim 72. Support for this new claim can be found throughout the specification, e.g. on pg. 31.

No new matter has been added by these amendments.

Claims 52-77 are pending in the application.

2. **Rejection of Claims 36-40 under 35 U.S.C. 112, second paragraph, for indefiniteness**

Claims 36-40 were previously rejected under 35 U.S.C. 112, second paragraph, for indefiniteness. The Examiner was concerned because Claims 36-40 recited the limitation "R²" and depended from Claim 28, but "R²" was not defined in Claim 28.

In response to the Examiner's request, Applicants have amended Claim 28 (now Claim 52) to include a definition of R². Support for this amendment can be found on pg. 7-8, 10, and 38-42. Thus, there is proper antecedent basis for Claims 36-40 to depend on Claim 28. Claim 36 has been amended to change the term "halogen" to "halo" for consistency with such term in independent Claim 28.

Accordingly, the rejection of Claims 36-40 under 35 U.S.C. 112, second paragraph, for indefiniteness has been overcome and Applicants request reconsideration of these claims.

3. **Rejection of Claims 28-31, 35, 44-47 and 49 under 35 U.S.C. 102 (b) for anticipation**

Claims 28-31, 35, 44-47 and 49 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Rosevear et al. The Examiner contends that compounds C and D on pg. 342 or Rosevear et al. anticipate compounds of the instant claims where R⁴ and R⁵ together form a phthalamide group, R³ is methyl, R⁶ is H, and R¹ is chloro. Applicants note that the Examiner's explanation describes Rosevear et al., p. 342 compound C, but not compound D. Examiner states "R¹ can also be methyl, see the definition of R." Presumably, Examiner is referencing the compound on p. 341, Table 2, of Rosevear et al. which corresponds to the compound of the instant claims where R⁴ and R⁵ together form a phthalamide group, R³ is methyl, R⁶ is H, and R¹ is methyl.

Applicants respectfully traverse this rejection and assert that Rosvear et al. does not disclose each and every element of the claimed invention.

In particular, in the compounds of the present invention, R³ is: C₁₋₆alkyl, which is substituted with halogen, hydroxyl or phenyl. The present claims do not include the compounds of Rosevear et al., such as compound C (wherein R³ is methyl).

To avoid any potential for confusion and in the interest of compact prosecution, Applicants have amend Claim 28 (now Claim 52) to expressly exclude three named compounds. The excluded compounds are:

N-[4-chloro-2-[(1,3-dihydro-1,3-dioxo-2H-isoindol-2-yl)methyl]phenyl]-acetamide (corresponding to Rosevear et al., compound C on p. 342, which is the same as Rosevear et al., p. 341, Table 2, thirteenth compound);

N-[2-[(1,3-dihydro-1,3-dioxo-2H-isoindol-2-yl)methyl]-4-methylphenyl]-acetamide (Rosevear et al., p. 341, Table 2, eleventh compound); and

N-[2-[(1,3-dihydro-1,3-dioxo-2H-isoindol-2-yl)methyl]phenyl]-acetamide (Rosevear et al., p. 341, Table 2, ninth compound). Because rejected Claims 29-31, 35, 44-47, and 49 all depend from Claim 28, the current amendment to Claim 28 (now Claim 52) overcomes all of the Examiner's rejections under 35 U.S.C. 102(b).

With regard to the Examiner's mention of compound D in Rosevear et al., Applicants respectfully note that compound D does not correspond to a compound embraced by the present claims. In Rosevear et al., compound D, the acetamide (-NHCOCH₃) and -CH₂NPht substituents on the phenyl ring are in a 1,3-arrangement. For compounds of the present invention, the amide (-NR⁶COR³) and -(CH₂)_nNR⁵COR⁴ groups on the phenyl ring of formula I must be in a 1,2-arrangement. Thus, Rosevear et al., compound D, does not anticipate the compounds of the present invention.

The Examiner indicated that Claim 49 (which corresponds to new Claim 53) is anticipated by Rosevear et al., stating: "Also, note that inasmuch as compound is in water, pharmaceutical composition is anticipated." Applicants respectfully submit that Rosevear et al. does not describe any compositions of the disclosed compounds in water. The chemical reactions in Rosevear et al. were conducted in concentrated sulfuric acid (see, e.g., Rosevear et al., pg. 339). Rosevear et al. also describes several reactions conducted in concentrated sulfuric acid "with some water added" (see, e.g., Rosevear et al. pg. 343, 346, 347), precipitation of the disclosed compounds from "ice/water" that was basified with ammonia (see, e.g., pg. 351), and the use of a "water bath" to heat chemical reactions (see, e.g., p. 352). However, Rosevear et al. does not describe the disclosed compounds in water, alone, and thus does not anticipate the pharmaceutical composition of new Claim 53 (previously presented Claim 49). Additionally, as new Claim 53 depends from amended Claim 28, new Claim 53 is not anticipated by Rosevear et al. since none of the compounds in amended Claim 28 are disclosed in Rosevear et al.

In light of the foregoing amendments and remarks, applicants request withdrawal of the rejection under 35 U.S.C. 102(b) and reconsideration of Claims 28-31, 35, 44-47 and 53.

4. Formal Objection to Claims 32-34, 41-43, and 50-51

Claims 33-34, 41-43 and 50-51 stand objected to as being dependent on a rejected base claim. Applicants note that previously presented Claims 50 and 51 have been cancelled, and replaced with new Claims 54 and 55, respectively. As requested by Examiner, the word "ameliorating" is not present in new Claim 55. In view of the foregoing amendments and remarks with respect to base Claim 28, Applicants respectfully submit that the objection to Claims 33-34, 41-43 and 50-51 should be withdrawn.

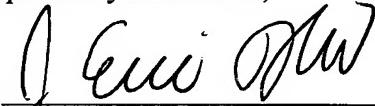
5. Allowable Claims

Applicants gratefully acknowledge that Claim 48 (now Claim 72) is allowable.

6. Conclusion

Applicants respectfully contend that the presently presented claims are allowable and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

By 
J. Eric Thies
Reg. No. 35,382
Attorney for Applicant

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-3904

Date: October 28, 2008